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| 09/628,315  | 07/28/2000  | Kazuo Ezawa          | AP32610-072817.0152             | 3474                        |
| 21003   | 7590        | 05/15/2008           |                                 |                             |
| BAKER BOTTS L.L.P.<br>30 ROCKEFELLER PLAZA<br>44TH FLOOR<br>NEW YORK, NY 10112-4498 |             |                      | EXAMINER<br>MOORTHY, ARAVIND K  |                             |
|   |             |                      | ART UNIT<br>2131                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>05/15/2008 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KAZUO EZAWA,  
DAVE ROBERTS,  
MICHAEL FOSTER AND  
JOHN KELLY

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Application No. 09/628,315  
Technology Center 2100

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Mailed: [Date of mailing]

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Before DALE M. SHAW *Chief Appeals Administrator*  
SHAW, *Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL

This application was received electronically at the Board of Patent Appeals and Interferences on March 13, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On July 23, 2007, appellants filed an Appeal Brief. On page 11, under the heading “Grounds of Rejection to be Reviewed on Appeal” the Appellant stated:

The rejection of claims 1-44 and 46-58 under 35 U.S.C. § 102(b) as being anticipated by Ishiguro et al. U.S. Patent No. 5,502,765.

In response, an Examiner's Answer was mailed on November 1, 2007. While the Answer notes that "The appellant's statement of the grounds of rejection to be reviewed on appeal is correct . . ." [page 3], the Examiner's Answer, the following § 103 rejections were made:

Claims 1-44 and 46-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishiguro et al (USP 5,502,765).

Claim 4 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al in view of Carlisle et al (USP 5,649,118).

A clarification of the claims to be applied in the rejection is required.

In addition, on page 2 of the Examiner's Answer, under the heading "Summary of Claimed Subject Matter" the examiner stated that "The Summary of claimed subject matter contained in the brief is deficient . . . ." However, there is no indication that the Appellants responded to the Examiner's Answer.

Correction is required. MPEP § 1205.03 states:

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

Lastly, Reply Brief was filed on December 3, 2007 in response to the Examiner's Answer mailed November 1, 2007. However, in accordance with the revision effective September 13, 2004, 37 CFR § 41.43 states:

. . . After receipt of a reply brief in compliance with [37 CFR] § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief ....

A review of the application indicates that the reply brief has not been considered by the examiner. Correction is required.

Accordingly, it is

**ORDERED** that the application is returned to the Examiner to:

- 1) to give a proper explanation of the grounds of rejection;
- 2) notify applicants to file a paper providing a summary of the claimed subject matter as required by 37 CFR § 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 4) for consideration of the reply brief filed June 29, 2007;
- 5) for written acknowledgment of entry of reply brief to the appellants; and
- 6) for such further action as may be appropriate.

Application No. 09/628,315

If there are any questions pertaining to this order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS/dal

cc: BAKER BOTTS L.L.P  
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